

REMARKS

Initially, Applicants have amended claims 176, 201, 253, 272-274, 280-288, 290-291 and 293 to more accurately claim the present invention and not for any reason related 5 to patentability. No new matter has been added. Applicants believe that the following comments will convince the Examiner that the rejections set forth in the January 17, 2003 Office Action have been overcome and should be withdrawn.

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I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a textbook 15 comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is 20 scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material related to the information contained in the textbook is displayed. Importantly, the present invention is designed to allow a

user to access programming material related to the textbook.

II. THE EXAMINER'S REJECTIONS

5 A. DOUBLE PATENTING

The Examiner rejected claims 168, 288, and 291 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter referred to as "the '863 10 patent").

"Although the scope of claims 168, 288 and 291 of the present application and claim 1 of [the] '863 patent are almost identical, the difference between the present claimed invention and the 15 '863 patent is that the present claimed invention is a broader recitation of the '863 patent." (January 17, 2003 Office Action Summary, p. 3, paragraph 2).

20 B. 35 U.S.C. § 103

The Examiner rejected claims 168-180, 183-185, 202-203, 228-251, 256, 259-262, 267-269, 272, 283, 288, and 290-293 under 35 U.S.C. § 103(a) as being unpatentable over Withnall et al. U.S. Patent No. 4,488,035 (hereinafter

referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields") and Nobles *et al.* U.S. Patent No. 4,820,167 (hereinafter referred to as "Nobles").

5 Withnall discloses a system that includes a feature recognition device that reads at least one machine recognizable feature printed on a travel ticket to display travel information on the display of a portable handset.

However, the Examiner admitted that:

10 "Withnall *et al* fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (January 17, 2003 Office Action Summary, p. 5, paragraph 5).

20 The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a

coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming /sound/pictorial/electronic/media data" on a "television /workbook."

5 The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention:

10 "in order to provide Withnall et al with a higher technology system wherein the user being provided with a full complete information [sic] in a flexible ways [sic] ... Furthermore, such modification would have been an obvious extension as taught by Withnall et al." (January 17, 2003 Office Action Summary, p. 5, paragraph 5).

15 The Examiner then admitted that Withnall and Fields fail to teach a system comprising information related to a textbook, which is claimed to be disclosed in Nobles. The Examiner argued that the combination of Nobles with Withnall and Fields would have been obvious to provide:

20 "a more user-friendly system wherein the students do not have to [be] concern[ed] about carrying [a] heavy bag of hardcopy textbooks, and they can retrieve their desired information that [is] related to their study readily through the

electronic textbook/device. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields." (January 17, 2003 Office Action Summary, p. 6, paragraph 5).

5 Also, the Examiner rejected claims 181-182, 187-188, 190, 196-197, 199-200, and 221-227 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as 10 "Roberts") and Malec et al. U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner admitted that Withnall, Fields, and Nobles fail to teach online or home shopping and a cable television data link, and argued that these features are disclosed by Roberts.

15 According to the Examiner, the combination of Roberts with Withnall, Fields, and Nobles would have been obvious and would provide:

"a faster system due to the benefit of cable television transmitting capability. Furthermore, 20 such modification would have been an obvious extension as taught by Withnall et al/Fields/Nobles et al to provide the user an alternative way of doing shopping." (January 17,

2003 Office Action Summary, pp. 6-7, paragraph
6).

Moreover, the Examiner admitted that Withnall, Fields,
Nobles, and Roberts all fail to disclose an Integrated
5 Service Digital Network ("ISDN") data link which, according
to the Examiner, is disclosed by Malec. In the opinion of
the Examiner, the combination of Malec with Withnall,
Fields, Nobles, and Roberts would have been obvious for
providing:

10 "a more accurate and faster system due to the
benefit of ISDN networking line[s]. Furthermore,
such modification would have been an obvious
extension as taught by Withnall et
al/Fields/Nobles et al/Roberts and would have
15 been merely a substitution of equivalents."

(January 17, 2003 Office Action Summary, p. 7,
paragraph 6).

Next, the Examiner rejected claims 186, 189, 191, 193-
195, 198, 201, 206-208, 210-211, 216-217, 220, 252-255,
20 257-258, 266, 271, 273-275, 286, and 289 under 35 U.S.C. §
103(a) as being unpatentable over Withnall as modified by
Fields and Nobles "as applied to claim 168" in view of
Bravman et al. U.S. Patent No. 5,401,944 (hereinafter
referred to as "Bravman"). The Examiner admitted that

Withnall, Fields, and Nobles fail to teach displaying information on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of
5 Withnall, Fields, Nobles, and Bravman would have been obvious for providing:

"a more flexibility [sic] system wherein the system is capable of providing the user all of his/her desired information about the trip/vacation that he/she is about to take, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Nobles et al." (January 17, 2003 Office
15 Action Summary, p. 8, paragraph 7).

Also, the Examiner rejected claims 204, 209, and 212 under 35 U.S.C. 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Waterbury German Patent No. DT 24 52 202 A1
20 (hereinafter referred to as "Waterbury"). The Examiner admitted that Withnall, Fields, and Nobles fail to teach an invisible machine recognizable feature, which is argued to be taught by Waterbury. The Examiner asserted that the

combination of Waterbury with Withnall, Fields, and Nobles would have been obvious for providing:

"a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Nobles et al."

(January 17, 2003 Office Action Summary, p. 9, paragraph 8).

Next, the Examiner rejected claims 205 and 219 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Tannehill et al. U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner admitted that Withnall, Fields, and Nobles all fail to disclose a "magnetic code/strip," which is argued to be disclosed by Tannehill. The Examiner contended that the addition of Tannehill to Withnall, Fields, and Nobles provides "an alternative feature for encoding data. Furthermore, such modification would have merely been a substitution of equivalents." (January 17, 2003 Office Action Summary, p. 9, paragraph 9).

Additionally, the Examiner rejected claims 213-215 and 218 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Schach *et al.* U.S. Patent No. 5 5,397,156 (hereinafter referred to as "Schach") and Waterbury. The Examiner admitted that Withnall, Fields, and Nobles fail to teach a watermark, which is argued to be taught by Schach. In the Examiner's opinion, the combination of Schach with Withnall, Fields, and Nobles 10 would have been obvious for aesthetic purposes. "[S]uch modification would have been an obvious extension as taught by Withnall *et al*/Fields/Nobles *et al.*" (January 17, 2003 Office Action Summary, p. 10, paragraph 10).

The Examiner then admitted that Withnall, Fields, Nobles, and Schach fail to teach an invisible watermark, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Nobles, Schach, and Waterbury would have been obvious for providing:

20 "a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating [sic] by [a] fraudulent user. Furthermore, such modification would have been an obvious extension

as taught by Withnall et al/Fields/Nobles et al/Schach et al." (January 17, 2003 Office Action Summary, pp. 10-11, paragraph 10).

Also, the Examiner rejected claims 192, 263-265, 270-5 271, 276-282, 284-285, and 287 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Nobles "as applied to claim 168" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall, Fields, 10 and Nobles fail to teach a display unit comprising a "personal planner/phone/pager," which is argued to be taught by Morales. In the Examiner's opinion, combining Withnall, Fields, Nobles, and Morales would have been obvious to provide:

15 "the user with the flexibility of selecting his/her desired display unit that is fitting [sic] his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Nobles et al." (January 17, 20 2003 Office Action Summary, p. 11, paragraph 11).

III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

A. DOUBLE PATENTING

The Examiner rejected claims 168, 288, and 291 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the '863 patent. In response, Applicants are filing a Terminal Disclaimer herewith to overcome the Examiner's double patenting rejection.

B. 35 U.S.C. § 103

10 The Examiner rejected claims 168-180, 183-185, 202-203, 228-251, 256, 259-262, 267-269, 272, 283, 283, 288, and 290-293 under 35 U.S.C. § 103(a) as being unpatentable over Withnall, Fields, and Nobles. Applicants respectfully disagree and submit that none of the aforementioned claims 15 are obvious in view of Withnall, Fields, and Nobles. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of 20 the claim limitations (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall, Fields, and Nobles exists.

5 "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital
10 Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir.
15 1984) (emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall, Fields, and Nobles to arrive at the various embodiments of Applicants' invention.
20 Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided by the references themselves. Applicants submit that no combination of these references would have been obvious to one of skill in the art at the time of Applicants'
25 invention. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual output from a
30 videodisc player coinciding with material presented in a

training manual. Moreover, the ticket validation system of Withnall has no apparent relation to Nobles school teaching system. Specifically, Nobles discloses a personal computer system designed to link to a master computer to download 5 educational material and also to facilitate in test or quiz administration. The differing purposes of these three references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive 10 step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall, Fields, or Nobles in any combination.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) 15 rejection actually support an "obvious to try" argument. Of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

20 Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

"It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit.

5 Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

Applicants submit that the only suggestion or
10 motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

15 In addition to the lack of suggestion or motivation to combine Withnall, Fields, and Nobles, there is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected
20 claims. Withnall discloses a machine capable of scanning a bar code on a commuter ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system for reading a bar code on a training manual for playing corresponding material from a videodisc. Nobles discloses a personal computer for administering tests and educational material.
25 Applicants respectfully submit that the combination of

Withnall, Fields, and Nobles cannot be successfully combined to disclose the means for accessing programming material associated with a database or the textbook having a machine recognizable feature of the claimed invention.

5 Importantly, claims 168, 288, and 291 all disclose the accessing of programming material resulting from recognition of a machine recognizable feature. The programming material of the present invention is designed such that it can be easily altered or updated at any time.

10 As a result, a user will be provided with the most recently updated version of the associated information (or programming material) upon scanning a textbook. This is not possible with the combination of Withnall, Fields, and Nobles. Specifically, audio/visual material from the

15 videodisc player of Fields requires that a videodisc player would be located on, for example, a bus. Therefore, anytime information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can

20 change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used. Furthermore, the audio/visual material could not be made dynamic by implementing the personal computer of Nobles because this system could only receive material directly

from an onboard computer system, and the personal computer is not even designed to receive data from a videodisc player. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other 5 such audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, 10 a system for achieving such transmission would need to be invented and implemented for remotely accessing such material.

Additionally, the textbook having a machine recognizable feature as claimed is not disclosed within the 15 combination. The Examiner relies on Nobles to provide "information related to a textbook." However, Nobles does not disclose a textbook of any sort. In fact, Nobles specifically states that his invention provides "a small, fully portable unit which is assigned to each student and 20 which replaces all textbooks." (col. 1, line 68 through col. 2, line 2). "The unit includes a display screen, typically a liquid crystal screen, approximating the size of an open book." (col. 2, lines 13-15). Thus, Nobles intends to replace textbooks and does not provide or even

contemplate any textbooks providing machine recognizable features. Moreover, Nobles never mentions machine recognizable features. Nobles, therefore, cannot be relied upon for disclosing a textbook having a machine 5 recognizable feature. Therefore, any attempt to combine Withnall, Fields, and Nobles to create the claimed invention would be unsuccessful and fails to provide the flexible, updateable system including a system for obtaining and surveying correlated programming material of 10 the claimed invention as opposed to a comparison of the identity of a printed code with a code stored in a database. Moreover, the advanced system for providing programming material and a textbook comprising a machine recognizable feature of the claimed invention are not 15 disclosed by the combination of these references.

In view of the foregoing, base claims 168, 288, and 291 cannot be unpatentable over Withnall, Fields, and Nobles. The remaining rejected claims are dependent on these claims and contain all of the limitations of their 20 respective base claims. Therefore, these claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the deficiencies of the Withnall, Fields, and Nobles combination regarding matter disclosed in dependent claims

and appended various other references including Roberts, Malec, Bravman, Waterbury, Tannehill, Schach, and Morales to the combination in order to provide the additional features of the dependent claims. However, the combination 5 of Withnall, Fields, and Nobles has been shown to be not only improper, but also to lack the disclosure of each and every element of the base claims. Because this combination is improper and incomplete, any further combination of references with Withnall, Fields, and Nobles would also be 10 improper. Thus, Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

Date: 4/17/2003


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